

Application No. 09/922,239
Amendment Dated August 27, 2003
Reply to Office Action of April 18, 2003

REMARKS/ARGUMENTS

By this Amendment, Claim 1 is amended, all of the other previously pending claims have been canceled and new Claims 49 - 61 have been added. New Claims 49 - 61 all depend either directly or indirectly upon amended Claim 1.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

The only independent claim in this case, i.e., Claim 1, was rejected as being obvious over U.S. Patent No. 4,864,740 (Oakley), in view of U.S. Patent Nos. 5,388,349 (Ogden), 5,675,914 (Cintron) and 4,808,458 (Watt).

As amended Claim 1 calls for a shoe insert having the following combined features: (1) a synthetic non-woven fabric layer, (2) with the fabric layer containing surface fibers oriented in a vertical direction and having an inside portion and an outside portion, (3) with the fabric layer being made from a non-woven material with a coefficient of friction along the inside portion between about 0.52 and 0.82, (4) with the insert having a non-slip surface disposed along the outside portion of the fabric layer, and (5) with the non-slip surface having a coefficient of friction that is greater than the coefficient of friction of the inside portion of the fabric.

These combined features are not found in the prior art. In particular, the primary reference, i.e., the patent to Oakley, discloses a shoe insert having a non-woven top layer, but fails to disclose the claimed coefficient of friction of the top layer. The secondary reference, i.e., the patent to Ogden, fails to make up for the deficiencies of the primary reference since it discloses an apertured

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thermoplastic material not a non-woven material. Moreover, the Ogden patent discloses that "The coefficient of friction of the apertured top layer herein is maintained such that the magnitude of the frictional engagement between the apertured top layer and sock is less than the magnitude of the frictional engagement between the sock and foot." (See Col. 5, lines 48- 54). Ogden mentions that for certain activities the coefficient of friction can be "increased to a level on the order of about 0.45 to 0.5" (See Col. 11, lines 43-46). In addition he hints that there may be uses with coefficients of friction higher (See Col. 11, lines 50 -57). However, nowhere does Ogden disclose the specific range being claimed, namely, 0.52 to 0.82. The examiner glosses over this deficiency by the statement that "discovering the optimum or workable ranges involves only routine skill in the art." This principle, while applicable in many situations, is not applicable here since it overlooks the fundamental fact that one would not even look to the secondary reference of Ogden to modify Oakley for a desired amount of a coefficient of friction since the insole of Ogden is not a non-woven material, as is the case of the insert of Oakley.

The tertiary reference, i.e., the patent to Cintron, fails to make up for the deficiencies of the primary and secondary references since it discloses use of suede for the inside (upper) surface of an insert for footwear. Claim 1 as amended herein calls for a synthetic fabric. Clearly, suede is not a synthetic fabric. Thus, there would be no reason to go to the Cintron patent for its teachings to modify the insert of Oakley.

The quaternary reference, i.e., the patent to Watt fails to make up for the deficiencies of the primary, secondary and tertiary references, since it merely discloses a suede-like fabric and method

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of making it. The Watt patent doesn't disclose the use of a synthetic material for the top surface of an insert for footwear, let alone one having the features called for in Claim 1 as amended, i.e., a synthetic non-woven fabric layer having a coefficient of friction between about 0.52 and 0.82. Thus, one would not go to the Watt patent for a teaching to use of such a fabric as the top surface of an insert for footwear.

Further still, as amended Claim 1 now calls for the coefficient of friction of the outside portion of the fabric layer to have a coefficient of friction that is greater than the coefficient of friction of the inside portion of the fabric. These combined features are not shown nor suggested by the patents to Oakley, Ogden, Cintron and Watt.

It is respectfully submitted that even if the four cited references did disclose all of the features now set forth in amended Claim 1, their combination would still be untenable as a valid rejection of Claim 1. In particular, any suggestion of obviousness could only be the result if the PTO reads the subject matter of the present invention into the Ogden reference (and the other cited art as well), where no such disclosure exists. The only way to make a rejection of the claims of this application on the basis of the four cited patents would be to impermissibly use the Applicants' own teachings to hunt through the prior art for the claimed elements and combine them as claimed. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed.Cir.1991). It is an accepted principle of patent law that the PTO may not "use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 23 USPQ 1780, 1784 (Fed. Cir. 1992).

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New Claims 42 - 61 depend either directly or indirectly upon Claim 1 and are hence patentable for reasons similar thereto.

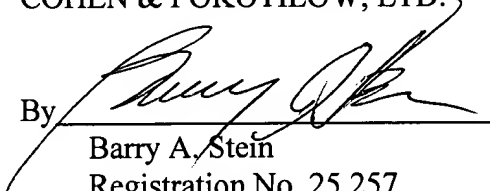
For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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